

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ITW



APPLICANTS: Robert H. Wollenberg

EXAMINER: A. K. Jackson

SERIAL NO.: 10/699,509

GROUP ART UNIT: 2856

FILED: October 31, 2003

Atty. Docket No. T-6298B (538-61)

FOR: HIGH THROUGHPUT SCREENING
METHODS FOR LUBRICATING
OIL COMPOSITIONS

DATED: March 31, 2005

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION SETTING
FORTH REQUIREMENT FOR RESTRICTION**


Sir:

In the Office Action dated March 7, 2005, the Examiner issued a requirement for restriction under 35 U.S.C. §121 categorizing original Claims 1-35 as follows: Group I made up of Claims 2-18 drawn to a method for screening lubricating oil compositions under program control, classified in class 73, subclass 54.01; Group II made up of Claim 19 drawn to a method for screening lubricating oil compositions under program control, classified in class 73, subclass 54.09; Group III made up of Claim 20, drawn to a method for screening lubricating oil compositions under program control, classified in class 73, subclass 53.06; Group IV made up of Claim 21, drawn to a method for screening lubricating oil compositions under program control, classified in class 73, subclass 53.06; and Group V made up of Claims 22-35, drawn to a method for screening lubricating oil compositions under program control, classified in class 73, subclass 54.05.

CERTIFICATE OF MAILING 37 C.F.R. §1.8(a)

I hereby certify that this correspondence (and any document referred to as being attached or enclosed) is being deposited with the United States Postal Service as first class mail, postage paid in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on March 31, 2005.

Dated: March 31, 2005


Michael E. Carmen

Initially, it is noted that Group V made up of Claims 22-35, drawn to a method for screening lubricating oil compositions under program control is incorrect. It is respectfully submitted that Claims 22-35 are instead drawn to a system.

In response to the requirement for restriction set forth by the Examiner, applicant provisionally elects, with traverse, to prosecute the subject matter of Claim 1 and the claims of Group I, i.e., Claims 2-18, for examination in this application. Applicant respectfully reserves the right to file one or more divisional applications to non-elected Claims 19-35 in the event the Examiner's restriction requirement is made final and such claims are canceled from the present application.

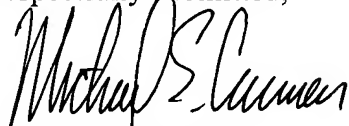
It is respectfully submitted that the requirement for restriction between the claims of Group I to Group V is improper and should be withdrawn.

Restriction is proper only if the claims are either independent or patentably distinct and the search and examination of the entire application would impose a serious burden on the examiner (MPEP § 803). Applicant respectfully traverses the Restriction Requirement because the Examiner has not provided sufficient reasons to show that such a burden exists. Here, all of applicant's claims are directed either to a method for screening lubricating oil compositions under program control (Claims 1-21); or to a system for screening a plurality of lubricating oil compositions (Claims 22-35) and as the Examiner has noted, all of the Groups are classified within Class 73. Applicant therefore submits that the Examiner, in searching for the subject matter of the claims in Class 73, would necessarily find art related to the method for screening lubricating oil compositions under program control of the claims of Group I; as well as the methods for screening lubricating oil compositions under program control of the claims of Groups II-IV and the system for screening a plurality of lubricating oil compositions of the claims of Group V.

Accordingly, applicant respectfully requests that the Examiner withdraw, or at the very least modify, the requirement for restriction and provide an action on the merits of nonelected Claims 19-35.

For the foregoing reasons, all of the claims of the application as presented herein, including the nonelected claims, are in condition for examination on the merits. Early favorable action is earnestly solicited.

Respectfully submitted,

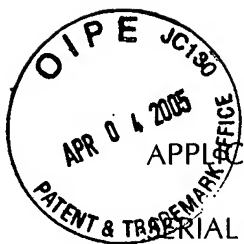
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Michael E. Carmen

Reg. No. 43,533

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AMENDMENT TRANSMITTAL FORM

Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☐ Small entity status of this application under 37 C.F.R. §§1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity under 37 C.F.R. §§1.9 and 1.27 is enclosed.
- ☒ No additional fee is required.

For	Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate (Small Entity)	Addit. Fee	Rate	Addit. Fee
TOTAL CLAIMS*	35	35	0	x 25 =	\$0	x 50 =	\$0
INDEPENDENT CLAIMS	4	4	0	x100 =	\$0	x200 =	\$0
<input type="checkbox"/> First Presentation of Multiple Dep. Claim				180		360	\$0

* If the entry in Col. 1 is less than entry in Col. 2, write "0" in Col. 3.

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".

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The Highest No. Previously Paid For (Total or indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

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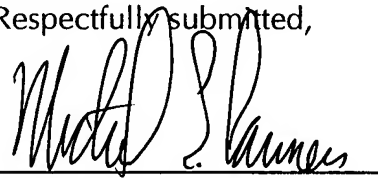
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Dated: March 31, 2005


Michael E. Carmen

- ☐ Please charge Deposit Account No. 04-1121 in the amount of \$____. Two (2) copies of this sheet are enclosed.
- ☐ A check in the amount of \$__ is enclosed.
- ☒ Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §§1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 04-1121. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 04-1121 therefor. A DUPLICATE OF THIS SHEET IS ENCLOSED.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written over a horizontal line.

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